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OFFICE OF PETITIONS

In re Application of	:	
Johnny B. Corvin	:	
Application No. 09/775,115	:	ON PETITION
Filed: February 1, 2001	:	
Attorney Docket No. UV-179	:	

This is a decision on the "Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181, filed June 9, 2009."

The petition is **DISMISSED**.

The above-cited application was held abandoned on January 10, 2009, after a proper response was not received following Notice of Panel Decision from Pre-Appeal Brief Review mailed December 9, 2008. A review of the relevant application file history reveals the following:

- On January 25, 2008, a final rejection is issued.
- On July 25, 2008, applicant filed a Notice of Appeal and a request for a pre-appeal brief review.
- On December 9, 2008, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed indicating that the application should proceed to the Board of Patent Appeals and Interferences and allowing an extendable period of one-month from the mailing date of the notice for applicant to file an appeal brief.
- On May 12, 2009, a Notice of Abandonment was mailed indicating that an appeal brief was not timely filed.

Petitioner requests that the holding of abandonment be withdrawn because the holding of abandonment was prematurely imposed. In support, petitioner maintains that the imposition of the holding of abandonment was premature. Implicit in petitioner's argument is the notion that the application is no longer pending and, therefore, had no time period running against it.

Petitioner's argument has been considered, but is not persuasive. A review of the application file history reveals that the Notice of Abandonment mailed May 12, 2009, was sent prematurely. The Notice of Panel Decision from Pre-Appeal Brief Review mailed December 9, 2008, set a shortened period for reply of one-month from its mailing date. This period was extendable five-months from the expiration of the shortened period for reply pursuant to 37 CFR 1.136(a). Petitioner, therefore, has until midnight June 9, 2009, in which to file an appeal brief with a request for extension of time within the fifth month. Accordingly, the mailing of the Notice of Abandonment on May 12, 2009, was premature. Notwithstanding, when there is a time period for response running against an application the fact that an

improper Notice of Abandonment was mailed does not relieve applicant of the responsibility of filing a timely and proper response to the preceding notice. In this case, applicant received the Notice of Panel Decision from Pr-Appeal Brief Review which allowed a one-month extendable period for reply, and applicant was responsible for filing an appeal brief, or other appropriate paper, within the period allowed. A review of the application file reveals that an extension of time within the fifth month was obtained on June 9, 2009, but no appeal brief is of record. The imposition of the holding of abandonment, albeit premature, does not toll the time period running against the application. Petitioner was still responsible for filing an appeal brief within the period set by the Notice of Panel Decision from Pre-Appeal Brief Review.

Furthermore, it is also noted that the petition to withdraw the holding of abandonment was filed June 9, 2009, which was within the extendable period for filing an appeal brief with said period ending at midnight on June 9, 2009. It is further noted that 37 CFR 1.181(f) provides that, "[t]he mere filing of a petition will not stay any period for reply running against the application, nor act to stay other proceedings." Petitioner was, therefore, responsible for timely prosecuting the application, which would include filing an appeal brief, or other appropriate paper, notwithstanding the filing of the petition to withdraw the holding of abandonment.

Section 711.03(c) of the Manual of Patent Examining Procedure provides, in pertinent part, that:

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

In this instance, there is no dispute as to whether the application is abandoned as an appeal brief, or other appropriate paper, was not filed within the allowable period. As indicated by MPEP 711.03(c) cited above, a petition to withdraw the holding of abandonment is not the appropriate course of action to return the application to a pending status. The most appropriate course of action is revival of the application pursuant to 37 CFR 1.137. Petitioner may file a petition under 37 CFR 1.137 to revive this application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
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By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

A handwritten signature in black ink, appearing to read "Kenya A. McLaughlin", written in a cursive style.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions